

## **REMARKS**

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of November 5, 2008. Claims 1-9, 11 and 14 have been amended. Claims 10 and 12 have been cancelled and claims 15-25 have been newly added. There has been no introduction of new matter.

Reconsideration of the Application is requested in view of the comments and amendments herein.

### **I. The Office Action**

Claims 1-9 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claim 10 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4 and 10-14 stand rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Flynn et al. (U.S. 6,068,910).

Claims 1-3 and 9-13 stand rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Murase (U.S. 4,637,957).

Claims 1-4 and 10-14 stand rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Maier et al. (U.S. 5,164,436).

Claims 1-3 and 9-14 stand rejected under 35 U.S.C. 103(a) as being obvious over Maier (U.S. 5,164,436).

Claims 1-6 and 10-14 stand rejected under 35 U.S.C. 103(a) as being obvious over Maier et al. or Flynn et al. in view of Leininger (U.S. 4,965,301).

Claims 1-5 and 7-14 stand rejected under 35 U.S.C. 103(a) as being obvious over Maier et al. or Flynn et al. in view of Hayes (U.S. 7,220,815).

Claims 1-4 and 9-14 stand rejected under 35 U.S.C. 103(a) as being obvious over Maier et al. and Flynn et al.

Claims 1-4 and 9-14 stand rejected under 35 U.S.C. 103(a) as being obvious over Brenner et al. (U.S. 6,740,697) and Flynn et al.

## **II. Rejection of Claims 1-9 Under 35 U.S.C. 101**

Claims 1-9 stand rejected under 35 U.S.C. 101 for allegedly being directed to non-statutory subject matter. Particularly, the Examiner asserts that the recited "the use of" is non-statutory subject matter. Claims 1-9 have been amended to recite "a method of" as suggested by the Examiner. Accordingly, the rejection of claims 1-9 should be withdrawn.

## **III. Rejection of Claim 10 Under 35 U.S.C. 112, Second Paragraph**

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 has been cancelled, thus rendering the rejection moot.

## **IV. Rejection of Claims 1-4 and 10-14 Under 35 U.S.C. 102(b) or 35 U.S.C. 103(a)**

Claims 1-4 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Flynn et al. (U.S. 6,068,910). Applicant respectfully traverses the rejection for at least the following reason. Flynn does not teach or suggest the invention as set forth in the subject claims.

As amended, independent claim 1, and similarly independent claim 14, recites a method of using a fatty acid ester as a slip additive in a thermoplastic molding composition in the production of molded polyethylene terephthalate articles in the form of bottle preforms. The method comprises incorporating the fatty acid ester into a bottle perform molded from polyethylene terephthalate. The  $\Delta E$  value in a bottle blown from the perform is less than 0.5.  $\Delta E = (\Delta L^{*2} + \Delta a^{*2} + \Delta b^{*2})^{1/2}$ , wherein  $\Delta L^*$  is the difference in the L value between the bottle including the additive and a standard which does not include the additive,  $\Delta a^*$  is the difference in  $a^*$  value between the bottle including the additive and a standard which does not include the additive and  $\Delta b^*$  is the difference in  $b^*$  value between the bottle including the additive and the standard which does not include the additive. Flynn does not teach or suggest such features as recited in the subject claims.

The invention of these claims is directed to solving the problem of enabling preforms to be packed more efficiently in a container using an additive that leads to reduced yellowing of the polymer. *See for example page 4, third paragraph of the specification as filed.* Flynn does not disclose the additive described in the claims of the present application, which is found to exhibit

a low amount of yellowing in the specific context of its use and enable more efficient preform packing.

Particularly, Flynn does not teach of including a fatty acid ester into a bottle preform molded from polyethylene terephthalate that results in a bottle blown from the preform having a  $\Delta E$  value of less than 0.5. Flynn is directed to polyester resin compositions for calendaring, and is involved with the process of film and sheet manufacture. Flynn is not directed to the problem with which the present method is concerned, particularly enabling preforms to be packed more efficiently in a container and using additives which are found to exhibit a low amount of yellowing.

Moreover, the teachings of Flynn do not make the invention(s) of the claims obvious because Flynn provides no suggestion or motivation that would lead a skilled person to modify Flynn's composition in such a way as to arrive at the claimed subject matter. The Examiner has not provided any evidence as to why Flynn's teaching would render the subject claims obvious. According to KSR, analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385, 1396 (2007). The Federal Circuit further stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). The Examiner has failed to provide any reasoning that would provide the necessary rationale as to obviousness.

For at least the reasons set forth above, it is submitted that Flynn fails to teach or suggest the invention as recited in independent claims 1 (along with claims 2-4, 11 and 13 that depend therefrom) and 14. Accordingly, it is respectfully requested that this rejection be withdrawn.

**V. Rejection of Claims 1-3 and 9-13 Under 35 U.S.C. 102(b) or 35 U.S.C. 103(a)**

Claims 1-3 and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Murase (U.S. 4,637,957). Applicant respectfully traverses the rejection for at least the following reason. Murase does not teach or suggest the invention as set forth in the subject claims.

As stated above, independent claim 1 is directed to a method for using a fatty acid ester as a slip additive in the production of molded polyethylene terephthalate articles. Murase

teaches a finish composition for polyester fiber for use in reinforcing rubber. The Examiner asserts that Murase teaches use of fatty acid esters in processing PET in Example of Application 1, wherein oleyl and oleate and rapeseed oil are taught. However, Murase fails to teach or suggest the production of molded polyethylene terephthalate articles in the form of bottle preforms, the method comprising incorporating said fatty acid ester into a bottle perform molded from polyethylene terephthalate, wherein the  $\Delta E$  value in a bottle blown from the perform is as described in the subject claims.

Additionally, similar to the Examiner's previous rejection, the Examiner fails to provide any reasoning as to why the teachings of Murase would render the subject claims obvious. Murase relates to a very different field of art than then subject claims and provides no insight or motivation for a skilled person to solve the problem with which the subject application is concerned. It would not be obvious to modify the teaching in the cited document and arrive at the claimed invention(s).

For at least the reasons set forth above, Murase does not anticipate or make obvious the invention as recited in independent claim 1, along with claims 2-3, 9, 11 and 13 that depend therefrom. As such, Applicant respectfully requests withdrawal of the rejection.

#### **VI. Rejection of Claims 1-4 and 10-14 Under 35 U.S.C. 102(b) or 35 U.S.C. 103(a)**

Claims 1-4 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Maier et al. (U.S. 5,164,436). Applicant respectfully traverses the rejection for at least the following reasons. Maier does not teach or suggest the invention recited in the subject claims.

As stated in more detail above, independent claim 1, and similarly independent claim 14, recites a method of using a fatty acid ester as a slip additive in a thermoplastic molding composition in the production of molded polyethylene terephthalate articles in the form of bottle preforms. The method comprises incorporating said fatty acid ester into a bottle perform molded from polyethylene terephthalate. The  $\Delta E$  value in a bottle blown from the preform is less than 0.5. The method is directed to enable preforms to be packed more efficiently in a container. Maier fails to teach or suggest the claimed invention(s).

Particularly, Maier fails to teach or suggest steps to enable preforms to be packed more efficiently in a container using an additive with a  $\Delta E$  value as described in the claims. The

Examiner asserts that Maier teaches transparent thermoplastic molded articles such as polyethylene terephthalate containing lubricants and mold releasing agents. The Examiner concludes that the molded article would have the instantly recited properties inherently. However, Maier appears to disclose preparation of sheet materials, not preforms packed into a container. It follows that the lubricants and release agents of Maier are not concerned with efficient packing or coloring. As such, it is not inherent that the molded article would have the claimed properties as asserted by the Examiner.

Moreover, Maier does not provide any insight for a skilled person to even address the problem of enabling preforms to be packed more efficiently in a container while exhibiting low yellowing. There is no motivation for a skilled person to modify the teaching in the document and arrive at the claimed subject matter, nor is any reasoning to support a modification provided by the Examiner. As such, the teaching of Maier neither anticipates nor makes obvious the subject claims. Accordingly, Applicant respectfully requests the rejection of independent claim 14, along with claims 2-4, 11 and 13-14 that depend therefrom, be withdrawn.

**VII. Rejection of Claims 1-3 and 9-14 Under 35 U.S.C. 103(a)**

Claims 1-3 and 9-14 are rejected under 35 U.S.C. 103(a) as being obvious over Maier (U.S. 5,164,436). Applicant asserts that as stated above in Section VI, Maier fails to teach or suggest the features of independent claim 1. Claim 9 depends from and includes all the limitations of claim 1. Accordingly, the rejection of claims 1-3 and 9-14 should be withdrawn.

**VIII. Rejection of Claims 1-6 and 10-14 Under 35 U.S.C. 103(a)**

Claims 1-6 and 10-14 are rejected under 35 U.S.C. 103(a) as being obvious over Maier et al. or Flynn et al. in view of Leininger (U.S. 4,965,301). Applicant asserts that independent claims 1 and 14 are patentable over both Maier and Flynn as discussed above. Leininger does not make up for the aforementioned deficiencies of Maier and Flynn, alone or in combination. Accordingly, Applicant respectfully requests the rejection of independent claims 1 (along with claims 2-6, 11 and 13 that depend therefrom) and 14, be withdrawn.

**IX. Rejection of Claims 1-5 and 7-14 Under 35 U.S.C. 103(a)**

Claims 1-5 and 7-14 are rejected under 35 U.S.C. 103(a) as being obvious over Maier et

al. or Flynn et al. in view of Hayes (U.S. 7,220,815). Applicant asserts that independent claims 1 and 14 are patentable over both Maier and Flynn as discussed more thoroughly above. Hayes does not make up for the aforementioned deficiencies of Maier and Flynn, taking the references alone or in combination. Accordingly, Applicant respectfully requests the rejection of independent claims 1 (along with claims 2-5, 7-11 and 13 that depend therefrom) and 14, be withdrawn.

**X. Rejection of Claims 1-4 and 9-14 Under 35 U.S.C. 103(a)**

Claims 1-4 and 9-14 are rejected under 35 U.S.C. 103(a) as being obvious over Maier et al. and Flynn et al. Applicant assumes that Examiner intended to include Brenner et al. (U.S. 6,740,697) in the cited rejection since Brenner is referred to in the Examiner's argument. Nonetheless, Applicant asserts that Brenner fails to make up for the insufficiencies of Maier and Flynn, either alone or in combination, as explained above. As such, Applicant respectfully requests that the rejection be withdrawn.

**XI. Rejection of Claims 1-4 and 9-14 Under 35 U.S.C. 103(a)**

Claims 1-4 and 9-14 are rejected under 35 U.S.C. 103(a) as being obvious over Brenner et al. (U.S. 6,740,697) and Flynn et al. Applicant respectfully traverses the rejection for at least the following reason. Brenner and Flynn, alone or in combination, do not teach or suggest the invention(s) as set forth in the present claims.

Brenner is directed to flame resistant thermoplastic moulding composition including an amorphous thermoplastic polymer and a flame retardant. Particularly, Brenner is concerned with polycarbonate having improved flame behavior. Brenner does not teach or suggest a method of using a fatty acid ester as a slip additive in a thermoplastic molding composition in the production of molded polyethylene terephthalate articles in the form of bottle preforms. Further Brenner is does not teach that the  $\Delta E$  value in a bottle blown from the preform is less than 0.5. As stated above in Section IV, Flynn also fails to teach or suggest such features.

Notwithstanding the fact that the combination of Flynn and Brenner would not result in or suggest the invention(s) as recited in the present claims, the combination of Flynn and Brenner is improper because the references are directed to non-analogous art. Particularly, Brenner is concerned with providing amorphous thermoplastic moulding compositions with improved flame

resistance. Flynn is concerned with polyester resin compositions for calendaring and is involved with the process of film and sheet manufacture. Applicant asserts that one skilled in the art would not make the aforementioned combination of Brenner and Flynn because each are directed to a different field and/or involve different materials and/or address different problems and/or different solutions.

For at least the reasons set forth above, Applicants respectfully submit that Brenner and Flynn do not, individually or in combination, teach the subject invention as recited in independent claims 1 (along with claims 2-4, 9, 11 and 13 that depend therefrom) and 14. As such, the rejection should be withdrawn.

### CONCLUSION


For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-9, 11, 13-25) are now in condition for allowance.

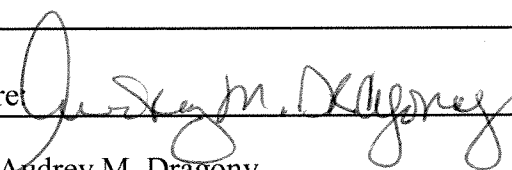
Respectfully submitted,

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